

P22010.A07



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Alain GOUX

Group Art Unit: 1771

Serial No : 10/069,126
(National Stage of PCT/FR00/02424)

Examiner: L. Salvatore

I.A. Filed : September 1, 2000

For : TEARAWAY ADHESIVE TAPE ON NONWOVEN SUPPORT

ELECTION WITH TRAVERSE

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is responsive to the Requirement for Restriction mailed from the Patent and Trademark Office March 26, 2004, in the above application. Inasmuch as the one-month shortened statutory period was originally set in the Office Action to expire on April 26, 2004, Applicants hereby request an extension of time for two (2) month and are concurrently filing a formal Request for Extension of Time, together with all requisite fees therefor. However, if any extension of time is deemed to be necessary, the same is hereby requested and the Patent and Trademark Office is authorized to charge any extension of time fees and any other fees necessary for maintaining the pendency of this application to Deposit Account No. 19-0089.

DISCUSSION OF RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 15-33, drawn to adhesive tape, classified in Class 428, subclass 343.

II. Claims 34-38, drawn to method for forming an adhesive tape, classified in Class 427, subclass various+.

The Examiner contends that the inventions are distinct, each from the other because the application has been filed under 35 U.S.C. 371 and a restriction requirement is appropriate under LACK OF UNITY rules, PCT rules 13.1 and 13.2, which permit in a single application claims to a first product and a first method of making. Applicant is requested by the Examiner to elect claims 15-33 directed to a product and claims 34-38 to a method of forming.

ELECTION

In order to be responsive to the requirement for restriction, Applicant elects the invention set forth in Group I, claims 15-33, with traverse.

However, for the reasons set forth below, Applicant submits that the restriction requirement is improper, and should be withdrawn, whereby an action on the merits of all of the pending claims is warranted.

TRAVERSE

Notwithstanding the election of the claims of Group I in order to be responsive to the requirement for restriction, Applicant respectfully traverses the requirement.

As noted above, the Examiner contends that the inventions are distinct, each from the other because the application has been filed under 35 U.S.C. 371 and a restriction requirement is appropriate under LACK OF UNITY rules, PCT rules 13.1 and 13.2, which permit in a single application claims to a first product and a first method of making. In contrast to this assertion by the

Examiner, Applicant points out that in determining unity of invention the criteria set forth in 37 C.F.R. 1.475 must be considered.

Specifically, §1.475(a) sets forth the definition of the requirement for unity of invention, and the unity of invention that must be satisfied, where a group of inventions is claimed, in order to have the right to include multiple inventions in a single application. In particular, §1.475(a) states that a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. In this regard, it is stated that:

Where a group of inventions is claimed in an application, the requirement for unity of invention shall be fulfilled only when there is technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole makes over the prior art.

Further, §1.475(b) defines several combinations of different categories of claims which always fulfill the unity of invention requirements of §1.475(a) where the same or corresponding special technical features is claimed. Of course, there are other combinations of claims which fulfill the requirement for unity of invention, but the determination of unity must be made under §1.475(a), not §1.475(b), as seen, for example, in §1.475(c). Thus, the requirement for unity of invention is fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The Office Action states:

[The] method of applying adhesive to a support and solidifying does not define a contribution over the prior art. For example, the method of applying liquid adhesive to a support and solidifying can be employed to produce a variety of laminates and

composites wherein the adhesive is not the outermost layer.

In this regard, Applicant points out that the adhesive tape in claims 15-33, and the process of preparing the adhesive tape in claims 34-38 include the same or corresponding special technical features, such as an adhesive and a support, and therefore conform with the requirements of unity of invention. Specifically, method claims 34-38 depend on product claim 15. Thus, all the method claims (claims 34-38) recite the adhesion tape of claim 15.

In any event, Applicant notes that combinations which satisfy unity of invention include a product and a process specially adapted for the manufacture of the product (§1.475(b)(1)), and a product and a process of use of the product (§1.475(b)(2)). Therefore, at a minimum, claims 15-38 satisfy unity of invention, and should be examined in this national stage application.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

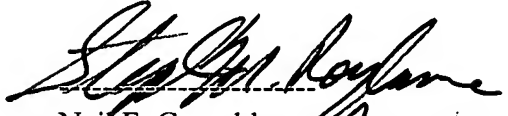
CONCLUSION

For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper because unity of invention is present, and the requirement should be withdrawn.

Withdrawal of the requirement for the restriction with examination of all pending claims, i.e., claims 15-38 is respectfully requested.

Favorable consideration with early allowance of claims 15-38 is most earnestly requested.

Respectfully submitted,
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